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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,157	01/19/2006	Wittich Kaule	2732-173	7236
6449 7590 06/11/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER CALLAWAY, JADE R				
ART UNIT 2872		PAPER NUMBER		
NOTIFICATION DATE 06/11/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

### Office Action Summary

**Application No.**

10/565,157

**Applicant(s)**

KAULE ET AL.

**Examiner**

JADE CALLAWAY

**Art Unit**

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-76 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendments to the claims, in the submission dated 4/21/08, are acknowledged and accepted.

***Election/Restrictions***

2. Applicant's election with traverse of Group 1(a) in the reply filed 4/21/08 is acknowledged. However, in view of the amendments to the claims, in the above mentioned submission, the restriction requirement of the Office Action dated 3/20/08 is withdrawn and the following requirement applies:

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1(a) claims 4-5, 10-12, 59 and 62-63, drawn to a security element with a transparent plastic layer.

Group 1(b), claims 6-7, drawn to a security element with subareas that form overprinted areas of the first reflection layer.

Group 1(c), claims 8 and 60, drawn to a security element with a metal layer.

Group 1(d), claims 13-14, drawn to a security element that has two adjoining areas.

Group 1(e), claims 15-25, 64-66, drawn to a security element that has a plurality of partial areas in at least one of the subareas.

Group 1(f), claim 26, drawn to a security element wherein the information is recognizable on at least one of rotating or tilting the element.

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Group 1(g), claim 27, drawn to a security element wherein the area or areas are surrounded by a diffraction structure.

Group 1(h), claim 28, drawn to a security element wherein at least one of the areas has a diffraction structure with an asymmetric profile.

Group 1(i), claim 29, drawn to a security element wherein at least one of the areas has a rainbow hologram, a volume hologram or a grating structure

Group 1(j), claim 30, drawn to a security element wherein at least one of the areas is formed as an embossed structure.

Group 1(k), claims 31-38, 58, 61 and 67-71, drawn to items with a security element

Group 1(l), claims 40, 43-45, 49, 52-54, and 72 drawn to method wherein a transparent plastic layer is embossed in the form of a relief structure.

Group 1(m), claims 41-42 and 50-51 drawn to a method wherein the subareas are produced by at least one of removing the first reflection layer or destroying the diffraction structure.

Group 1(n), claims 46-47 and 73, drawn to a method wherein the subareas are produced by overprinting the first reflection layer with a neutralizing printing ink.

Group 1(o), claims 55-57, 74-75, drawn to a method wherein at least two areas with diffraction structures are produced each comprising a plurality of partial areas that are interlaced into each other.

4. Claims 1 and 39 link Groups 1(a)-1(o). Claims 2, 3, 9, 48 and 76 will be examined along with the elected invention of Group 1(a)-1(o).

5. The inventions listed as Groups 1(a)-1(o) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is a security element that has at least one area with a diffraction structure, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas which do not take part in the reconstruction, characterized in that the information represented by the subareas is recognizable only under the specific viewing conditions. This element cannot be a special technical feature under PCT rule 13.2 because the system is shown in the prior art. European Patent 1197350 (A3) teaches a security element substantially as claimed in claim 1 and 39.

6. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JADE CALLAWAY whose telephone number is (571)272-8199. The examiner can normally be reached on Monday to Friday 7:00 am - 4:30 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRC

/Jade R. Callaway/

Examiner, Art Unit 2872

/Stephone B. Allen/

Supervisory Patent Examiner, Art Unit 2872